

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUCA COMAI, MARGARET P. SANGER and STEPHEN D. DAUBERT

Appeal No. 95-4496
Application 07/985,742¹

MAILED

JUL 27 1999

HEARD: July 12, 1999

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WINTERS, GRON and SPIEGEL, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not in condition for appeal. Accordingly, we remand the application to the examiner to take appropriate action and for further proceedings consistent with this opinion.

¹Application for patent filed December 4, 1992. According to appellants, this application is a continuation of application 07/431,429, filed November 3, 1989, which is a continuation-in-part of application 07/404,283, filed September 7, 1989, both now abandoned.

35 U.S.C. § 112, SECOND PARAGRAPH

Initially, we refer to four specific promoter constructs identified by appellants in their specification: (1) the "full length" figwort mosaic virus 34S promoter; (2) the "half length" promoter; (3) the "quarter length" promoter; and (4) the "TATTTAA only" promoter. (instant specification, paragraph bridging pages 8 and 9.) Based on our review of the record, including the Appeal Brief and the Examiner's Answer, and further based on the oral argument held July 12, 1999, under the provisions of 37 CFR § 1.194, we think it apparent that claims 20, 22 through 28, 30, 33 through 36 and 43 cover more than those specific constructs. The question is, how much more? It is reasonably clear that the appealed claims "read on" the four promoter constructs identified by appellants in their specification. It is unclear, however, what more the claims cover. What are the outer limits of the claimed subject matter?

Where, as here, the full scope of the claims is unclear, the examiner cannot engage in a meaningful analysis under 35 U.S.C. § 112, first paragraph, or 35 U.S.C. § 103. Cf. In re Moore 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971); (claims must be analyzed first to determine exactly what subject matter they encompass before considering the written description requirement of 35 U.S.C. § 112, first paragraph); and In re Geerdes, 491 F.2d 1260, 1262, 180 USPQ 789, 791 (CCPA 1974) (before considering rejections under 35 U.S.C. § 103 and 35 U.S.C. § 112, the

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court first must decide "whether the claims include within their scope the presence of recognized blowing agents"). Nor can we engage in a meaningful analysis on appeal. Accordingly, we return this application to the examining corps with instructions that the examiner reevaluate the patentability of claims 20, 22 through 28, 30, 33 through 36 and 43 under 35 U.S.C. § 112, second paragraph. We recommend that both appellants and the examiner consider and clarify whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. Special attention should be paid to that portion of the claims covering more than the four promoter constructs identified by appellants in their specification. Again, what are the outer limits of the claimed subject matter?

35 U.S.C. § 112, FIRST PARAGRAPH

We next invite attention to University of California v. Eli Lilly and Co. 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997), decided after appellants and the examiner briefed this case. In Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406, the court makes clear that claims drawn to genetic material are treated differently than claims drawn to

chemical materials in determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph. Claims drawn to genetic material, such as DNA, require a high degree of specificity, usually achieved by reciting the sequence of nucleotides that make up the DNA, in order to comply with the statute.

In light of this new case law, we return the application to the examining corps with instructions that the examiner reevaluate the patentability of claims 20, 22 through 28, 30, 33 through 36 and 43 for compliance with the written description requirement of 35 U.S.C. § 112, first paragraph. We shall not reach this issue now. Nevertheless, it appears to us that the instant specification provides written descriptive support for claims drawn to the four specific promoter constructs identified by appellants in their specification, paragraph bridging pages 8 and 9. The appealed claims are not so limited. On return of this application to the examining corps, we recommend that the examiner determine whether any of the appealed claims are based on a specification which provides written descriptive support for the full scope of the claimed subject matter with the kind of specificity required by University of California v. Eli Lilly and Co. 119 F.3d at 1568, 43 USPQ2d at 1406.

Further, at the oral hearing on July 12, 1999, we asked counsel² whether the instant specification provides written descriptive support for any figwort mosaic virus

² Carl J. Schwedler, Esq., Reg. No. 36924, represented appellants at the oral hearing.

34S promoter other than the four specific promoter constructs identified in the specification, paragraph bridging pages 8 and 9. Counsel answered that question in the affirmative, arguing that a person skilled in the art has knowledge of Richins³ and that the specification, coupled with Richins, provides support for the appealed claims which cover more than those four constructs. It appears that appellants would rely on Richens to augment written descriptive support for those claims covering more than the four promoter constructs identified in the specification.

We point out, however, that it is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned but failed to disclose. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Therefore, appellants' efforts to reach outside the specification for written descriptive support, i.e., to support claims covering prompter constructs not identified in the specification, is unavailing. The specification itself must provide adequate written descriptive support for the claimed invention. 35 U.S.C. § 112, first paragraph.

³ Richins, et al. (Richins), "Sequence of figwort mosaic virus DNA (caulimovirus group)", Nucleic Acids Research, Vol. 15, Number 20, pp. 8451-8466 (1987).

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On return of this application to the examining corps, when the examiner reevaluates the patentability of claims 20, 22 through 28, 30, 33 through 36 and 43 for compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, we recommend that the examiner consider the foregoing remarks and the principles of law enunciated in Lockwood v. American Airlines, Inc. 107 F.3d at 1571-1572, 41 USPQ2d at 1966.

THE EXAMINER'S REJECTIONS UNDER 35 U.S.C. § 103

All of the appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Shah⁴ and Sanders⁵, considered together with Richins⁶ or, alternatively, considered together with Richins and Shepherd⁷. See the Examiner's Answer, section (9), pages 4 through 6.

In setting forth these rejections, the examiner does not refer to, analyze, or apply the cited prior art against, any particular claim or claims. For this reason, the stated rejections are not susceptible to a meaningful review. As stated in In re Hiniker Co.,

⁴ Shah et al. (Shah), U.S. Pat. No. 4,940,835, issued July 10, 1990.

⁵ Sanders et al. (Sanders), "Comparison of cauliflower mosaic virus 35S and nopaline synthase promoters in transgenic plants", Nucleic Acids Research, Vol. 15, Number 4, pp. 1543-1558 (1987).

⁶ Richins, et al. (Richins), "Sequence of figwort mosaic virus DNA (caulimovirus group)", Nucleic Acids Research, Vol. 15, Number 20, pp. 8451-8466 (1987).

⁷ Shepherd, et al. (Shepherd), Figwort Mosaic Virus: Properties of the Virus and Its Adaption to a New Host", Phytopathology, Vol. 77, No. 12, pp. 1668-1673 (1987).

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150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), "the name of the game is the claim".

On return of this application to the examining corps, we recommend that the examiner step back and reevaluate the patentability of claims 20, 22 through 28, 30, 33 through 36 and 43 under 35 U.S.C. § 103 over the cited prior art. If the examiner believes that appellants' claimed subject matter is unpatentable under 35 U.S.C. § 103, the examiner should issue an appropriate office action explaining this position fully and focussing on the claims. In this regard, we recommend that the examiner follow the format outlined in MPEP § 706.02(j) entitled "Contents of a 35 U.S.C. § 103 rejection".

For the purposes of this appeal, appellants have grouped all of the claims together in arguing the rejections under 35 U.S.C. § 103. See the Appeal Brief, page 4. Nevertheless, at a minimum, the examiner should apply the cited prior art against the broadest claim on appeal, claim 20. On this record, the examiner does not refer to, analyze, or apply the cited prior art against, any particular claim or claims.

CONCLUSION

For the reasons set forth in the body of this opinion, we find that the case is not in condition for a decision on appeal. Accordingly, we remand the application to the

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examiner to take appropriate action and for further proceedings consistent with this opinion.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Sherman D. Winters

SHERMAN D. WINTERS)
Administrative Patent Judge)

Teddy S. Gron)
TEDDY S. GRON)
Administrative Patent Judge)

) BOARD OF PATENT
APPEALS AND
INTERFERENCES

Carol A. Spiegel)
CAROL A. SPIEGEL)
Administrative Patent Judge)

vsh

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Elizabeth Lassen
Calgene Incorporated
1920 Fifth Street
Davis, CA 95616